

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77752741
LAW OFFICE ASSIGNED	LAW OFFICE 110
MARK SECTION (no change)	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	<u>evi_168981314-092502529 . 282019999016.pdf</u>
CONVERTED PDF FILE(S) (14 pages)	<u>\\TICRS\EXPORT11\IMAGEOUT11\777\527\77752741\xml5\RFR0002.JPG</u>
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DESCRIPTION OF EVIDENCE FILE	Response to Final Office Action
SIGNATURE SECTION	

RESPONSE SIGNATURE	/Meredith M. Wilkes/
SIGNATORY'S NAME	Meredith M. Wilkes
SIGNATORY'S POSITION	Attorney of Record, Ohio Bar Member
DATE SIGNED	04/04/2011
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Mon Apr 04 09:28:57 EDT 2011
TEAS STAMP	USPTO/RFR-168.98.131.4-20 110404092857716254-777527 41-480c7c073d03e334ae657f c3d1c05c5051-N/A-N/A-2011 0404092502529732

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Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **77752741** has been amended as follows:

EVIDENCE

Evidence in the nature of Response to Final Office Action has been attached.

Original PDF file:

evi_168981314-092502529 . 282019999016.pdf

Converted PDF file(s) (14 pages)

Evidence-1

Evidence-2

Evidence-3

Evidence-4

Evidence-5

Evidence-6

Evidence-7

Evidence-8

Evidence-9

Evidence-10

Evidence-11

Evidence-12

Evidence-13

Evidence-14

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Meredith M. Wilkes/ Date: 04/04/2011

Signatory's Name: Meredith M. Wilkes

Signatory's Position: Attorney of Record, Ohio Bar Member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 77752741

Internet Transmission Date: Mon Apr 04 09:28:57 EDT 2011

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TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of : Nordic Naturals, Inc.
Application No. : 77/752,741
Filed : June 5, 2009
Mark : CHILDREN'S DHA (Stylized)
Examiner : Tarah Hardy Ludlow
Law Office : 110
Attorney Docket: : 282019-999016

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

RESPONSE TO OFFICE ACTION

This memorandum is in response to the Office Action of October 4, 2010 ("Office Action"). In the Office Action, the Examining Attorney refused registration to Nordic Naturals, Inc. ("Applicant") for the stylized mark "CHILDREN'S DHA" ("Applicant's Mark") on grounds that Applicant's Mark is generic under Section 2(e)(1) of the Trademark Act, or that Applicant's Mark is merely descriptive under Section 2(e)(1) of the Trademark Act and has not acquired distinctiveness under Section 2(f) of the Trademark Act, or that Applicant's Mark's stylization is insufficient to warrant registration. In so doing, the Examining Attorney failed to meet applicable evidentiary standards and misapplied the law. As set forth below, Applicant respectfully states that Applicant's Mark is not generic, has acquired distinctiveness, and is sufficiently stylized to warrant registration. Thus, Applicant's Mark is in a condition for publication and reconsideration is respectfully requested.

1. The Examining Attorney Misapplied The Law

The Examining Attorney claims that Applicant's Mark is not capable of registration. Yet, to come to this result, the Examining Attorney makes several errors of law. First, the Examining Attorney erroneously dissects Applicant's Mark. As a result, the Examining Attorney considers the Mark's in constituent parts rather than as a whole. Second, the Examining Attorney misapplies the test for genericness. This misapplication results in a determination that Applicant's Mark refers to the genus "nutritional supplements containing DHA."

a. Applicant's Mark Was Improperly Dissected

As a whole, Applicant's Mark is not generic. Applicant's Mark, however, was considered in pieces. The Examining Attorney improperly dissected Applicant's Mark. In *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-546 (1920), the Supreme Court stated the fundamental "anti-dissection" rule: "The commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail. For this reason, it should be considered in its entirety." *See also: In re Steelbuilding.com*, 415 F.3d 1293, 1297 (Fed. Cir. 2005) ("An inquiry into the public's understanding of a mark requires consideration of the mark as a whole."). The Examining Attorney has submitted exhibits defining "DHA" and "Children," and noted that "the individual terms" of Applicant's Mark are generic. Yet, such an analysis is irrelevant. It runs afoul of the anti-dissection rule.

In an attempt to justify dissection of Applicant's Mark, the Examining Attorney cites *In re Gould Paper Corp.*, 834 F.2d 1017 (Fed. Cir. 1987), *In re Wm. B. Coleman Co.*, 93 U.S.P.Q.2d 2019 (T.T.A.B. 2010), and the Trademark Manual of Examining Procedure § 1209.09(c)(i). This reliance is misplaced. These sources merely explain that dissection of a mark is appropriate in the case of a compound term. *See, e.g.: In re Gould Paper Corp.*, 834

F.2d at 1018-1019 (Fed. Cir. 1987) (the union of “SCREEN” and “WIPE” results in the divisible designation, “SCREENWIPE”); *In re Wm. B. Coleman Co.*, 93 U.S.P.Q.2d at 2021 (T.T.A.B. 2010) (holding that for compound terms, dissection is appropriate; for phrases, the mark must be considered as a whole); TMEP § 1209.01(c)(i).

A compound word is one word formed by the union of two separate words. *See*: www.dictionary.com. “CHILDREN’S DHA” is not a compound word because it is composed of more than one word. It is a phrase. As such, *Gould* does not apply. *In re The American Fertility Society*, 188 F.3d 1341 (Fed. Cir. 1999); *In re Active Ankle Systems, Inc.*, 83 U.S.P.Q.2d 1532, 1534 (T.T.A.B. 2007) (holding a multiple-word mark is a phrase, so *Gould* does not apply); TMEP § 1209.01(c)(i) (stating that *Gould* does not apply to phrases).

The *American Fertility* case is a useful example. In that case, the applied-for mark was “AMERICAN SOCIETY FOR REPRODUCTIVE MEDICINE.” The Board tried to evaluate the mark in pieces, requiring a disclaimer for “Society for Reproductive Medicine,” on the grounds that that segment was generic. Referring to the mark as a “phrase,” the Federal Circuit explicitly held that it does not dissect phrases. *Id.* at 1347-1348. Furthermore, the court noted that any “dissection” in case law only occurred regarding compound words. *Id.* The court then rejected the Board’s inquiry into the constituent parts of a phrase, and stated that the rule is to evaluate marks as a whole. *Id.* at 1349.

As similar result is warranted in this case. Like the designation in *American Fertility*, Applicant’s Mark is a phrase because it is composed of more than one word. Thus, the holdings in *Gould* and *In re Wm. B. Coleman*, relied upon by the Examining Attorney, which purport to show that the individual terms of Applicant’s Mark are generic, do not control. Furthermore, while the Examining Attorney correctly asserts that the Trademark Manual of Examining

Procedure §1209.01(c)(i) is applicable, it stands for Applicant's position that "CHILDREN'S DHA" must be evaluated as a whole.

b. Applicant's Mark Is Not Generic Under Section 2(e)(1) of Trademark Act

The substantive test for genericness involves a two-step inquiry. "First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?" *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 990 (Fed. Cir. 1986); TMEP § 1209.01(c)(i). "Evidence of the public's understanding of the term may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers, and other publications." *In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 1570 (Fed. Cir. 1987). "The burden of showing that a proposed trademark is generic remains with the Patent and Trademark Office." *Id.* at 1571.

The Patent and Trademark Office fails to meet its burden. Applicant's Mark is not generic. The relevant public does not understand Applicant's Mark to refer primarily to the genus of goods at issue. In step one of the genericness test, the Examining Attorney defines the genus of the identified goods as "nutritional supplements containing DHA." There are several nutritional supplements containing DHA that are specifically intended for adults. *See, e.g.*: www.nordicnaturals.com/en/Products/Product_Details/98/?ProdID=1434 (Nordic Naturals DHA supplement for pregnant women); www.spectrumorganics.com/?id=283 (Spectrum Naturals DHA supplement for pregnant women); www.naturemade.com/Products/Multivitamins/Prenatal-DHA-Liquid-SoftGel (Nature Made DHA supplement for pregnant women). Since it would be unreasonable to exclude adult-oriented nutritional supplements containing DHA from the genus

“nutritional supplements containing DHA,” the Examining Attorney’s genus must include such supplements formulated for adults.

In step two, the Examining Attorney asserts that “*CHILDREN’S DHA*” is understood by the relevant public to refer primarily to the genus “nutritional supplements containing DHA.” This assertion is unreasonable, contradicts the English language, lacks any supporting evidence, and is rebutted by Applicant’s evidence that the public associates “*CHILDREN’S DHA*” exclusively with Applicant’s product.

i. “CHILDREN’S DHA” Does Not Refer To A Genus of Product.

The Examining Attorney’s assertion is unreasonable in view of the fact that there are nutritional supplements containing DHA that are formulated for adults. Neither common sense nor the English language countenance a suggestion that consumers seeking nutritional supplements containing DHA for *adults* would ask for “*CHILDREN’S DHA*.” As such, “*CHILDREN’S DHA*” does not refer to the genus “nutritional supplements containing DHA.” For this reason Applicant’s Mark is not generic under step two of the genericness test.

ii. No Evidence Supports The Notion That “CHILDREN’S DHA” Is Used To Refer To The Genus Of Nutritional Supplements Containing DHA

In the unlikely event it might be believed the notion that “*CHILDREN’S DHA*” is understood to refer to the genus of nutritional supplements containing DHA, the Examining Attorney cites no evidence in support of this assertion. Absent this evidence, Applicant’s Mark should proceed to publication.

To support its claim that Applicant’s Mark refers to a “genus” of goods, the only evidence referenced in the Office Action is a citation to the web site www.wisegeek.com. Such reliance is misplaced. Insofar as the www.wisegeek.com web site could be construed as

authoritative (which it is not) it is unreasonable to assert that “CHILDREN’S DHA” refers to a genus of product since there are adult-formulated nutritional supplements containing supplements that contain fish oil, omega-3 fatty acid and dososahexaenoic acid. .

Lacking any evidence that “CHILDREN’S DHA” refers to the genus of “nutritional supplements containing DHA,” the Examining Attorney has not carried the substantial burden of proving that Applicant’s Mark refers to the genus at issue. As such, Applicant’s Mark is not generic.

iii. Evidence Of Actual Public Understanding Of The Term Was Improperly Ignored

Not only is it unreasonable to assert that the mark “CHILDREN’S DHA” is understood by the public to refer to the genus “nutritional supplements containing DHA,” there is affirmative evidence that “CHILDREN’S DHA” is understood by the relevant public to refer specifically to Applicant’s product. As noted above, “[e]vidence of the public’s understanding of the term may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers, and other publications.” *Merrill Lynch*, 828 F.2d at 1570. Though the Examining Attorney cited the same passage from *Merrill Lynch* in the Office Action, the Examining Attorney ignored several pieces of competent evidence showing that the mark is understood to reference Applicant’s product.

Applicant has submitted excerpts from trade journals using “CHILDREN’S DHA” to refer specifically to Applicant’s product. *See*: Response to Office Action Filed March 9, 2010, Exhibit 2. Applicant has submitted affidavits from industry professionals stating that “CHILDREN’S DHA” is associated exclusively with Applicant’s product. *See*: Response to Office Action Filed March 9, 2010, Exhibit 4. Applicant has also submitted an affidavit by Joar Opheim, the Chief Executive Officer of Nordic Naturals, stating that the mark “CHILDREN’S

DHA” was introduced and used exclusively by Applicant for five years. *See*: Response to Office Action Filed March 9, 2010, Exhibit 1. The particular import of Mr. Opheim’s declaration is that for the first five years of its use, any understanding of the term “CHILDREN’S DHA” was in reference to Applicant’s product. Most notably, there is no evidence to the contrary.

While the Examining Attorney presented no evidence that anyone understands “CHILDREN’S DHA” to refer to the genus “nutritional supplements containing DHA,” Applicant has presented evidence that the relevant public understands Applicant’s Mark to refer specifically to Applicant’s product. In view of the “heightened burden” for the Office to show genericness, *In re Hotels.com LP*, 573 F.3d 1300, 1302 (Fed. Cir. 2009); *See also: In re K-T Zoe Furniture, Inc.*, 16 F.3d 390, 393 (Fed. Cir. 1994) (“A strong showing is required when the Office seeks to establish that a [mark] is generic.”), In short, the Examining Attorney has failed to demonstrate that Applicant’s Mark is generic.

c. The “Clear Evidence” Standard Has Not Been Met

In order to refuse registration on the grounds that a mark is generic, the Examining Attorney bears the burden of “substantial[ly] showing that the matter is in fact generic . . . based on clear evidence of generic use.” *In re Steelbuilding.com*, 415 F.3d at 1296; TMEP § 1209.01(c)(i). “When a fact is required to be found by ‘clear evidence’ and not a mere preponderance,” it is a heightened evidentiary burden. *In re Hotels.com LP* at 1302; *In re K-T Zoe Furniture, Inc.* at 393. The burden is high because of the significant ramifications of putting an applicant’s mark into the public domain. *In re Hotels.com LP* at 1303. It is imperative that the PTO does not over-limit registration, lest “valuable trademark rights will be lost.” *In re Ideal Industries, Inc.*, 508 F.2d 1336, 1338 (C.C.P.A. 1975).

i. Evidence Of Infringement Is Not Evidence Of Genericness

To support a claim of genericness, the Examining Attorney cites to evidence of infringement. The Examining Attorney claims that this purported evidence of some competitors' infringing use of Applicant's Mark does not render the mark generic. What the Examiner ignores, however, is that Applicant introduced and this Mark exclusively for several years before competitors adopted it. Any such use of the mark by a competitors is obvious infringement, not evidence of genericness.

The holding in *Merrill Lynch*, 828 F.2d 1567 (Fed. Cir. 1987), is illustrative. In *Merrill Lynch*, Merrill Lynch had introduced and marketed a service under the previously-unused phrase "Cash Management Account." For several years, Merrill Lynch used the term exclusively. When Merrill Lynch attempted to register the phrase to identify other services, the Trademark Trial and Appeal Board refused registration on grounds that the mark was generic because third parties had used the phrase "Cash Management Account" after Merrill Lynch introduced it. On appeal, the Federal Circuit held that evidence of Merrill Lynch's first use, and the competitors' subsequent use was insufficient to "clearly place [the] mark in the category of a generic or common descriptive term." *Merrill Lynch*, 828 F.2d at 1571. The Federal Circuit overturned the Board's finding of genericness because the demonstrated use did "not show, by clear evidence, that the financial community views and uses the term CASH MANAGEMENT ACCOUNT as a generic, common descriptive term for the brokerage services to which *Merrill Lynch first applied* the term. *Id.* (emphasis added).

The holding in *Merrill Lynch* dictates that the Examining Attorney's analysis of third party use is wrong. As in *Merrill Lynch*, evidence in this case shows that Applicant was first to

use Applicant's Mark, it did so exclusively for several years, and that some competitors subsequently co-opted the term. Despite competitors' widespread infringement, as in *Merrill Lynch*, Applicant's evidence of first and exclusive use of Applicant's Mark precludes finding sufficiently clear evidence to place Applicant's Mark in the category of a generic or common descriptive term.

ii. The Words In Applicant's Mark Alone Do Not Determine Genericness

In the Office Action, the Examining Attorney states, without citation to authority, that "[a] word or term that is the name of a key ingredient, characteristic, or feature of the goods and/or services *can be* generic for those goods and/or services and thus, incapable of distinguishing source." (emphasis added). This uncited contention sheds no light upon a genericness inquiry and should be afforded no weight. Of course a combination of words "can be generic." This does not mean that Applicant's Mark is generic nor does it "necessitate a finding of genericness" as alleged by the Examiner.

Indeed, such words and terms can also be *not generic, and thus capable* of distinguishing source. There are several examples of marks being registered when the designations include words or terms that are names of key ingredients, characteristics or features of the marks. *See, e.g.: In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341 (Fed. Cir. 2001) ("1-888-M-A-T-T-R-E-S-S" held not generic for mattress sales); *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567 ("CASH MANAGEMENT ACCOUNT" held not generic for money management services); *In re Federated Dept. Stores Inc.*, 3 U.S.P.Q.2d 1541 (T.T.A.B. 1987) ("THE CHILDREN'S OUTLET" ("OUTLET" disclaimed) held not generic for children's clothing sales)

iii. Doubt About The Proper Classification Of Applicant's Mark Must Be Resolved In Applicant's Favor

Doubts about the classification of a mark must be resolved in an applicant's favor. *In re Merrill Lynch*, 828 F.2d at 1571. In the *Merrill Lynch* case, the evidence against the applicant included information that third parties and trade magazines had been using the term "generically." There was also evidence that the financial community had been using the term to refer to the applicant. Faced with this conflicting evidence, the Federal Circuit held that the "mixture of use" precluded a finding of genericness. *Id.* at 1571. The court held, "[i]t is incumbent upon the Board . . . to resolve reasonable doubt in favor of the applicant, in accordance with practice and precedent." *Id.*

The evidence submitted in this case has raised doubts by showing, at a minimum, mixed uses of Applicant's Mark. These mixed uses include proper usage by the Applicant, source recognition by the relevant public, and infringing use by third parties. As in the *Merrill Lynch* case, these uses do not clearly show Applicant's Mark to be generic.

2. Applicant's Mark has Acquired Distinctiveness under Section 2(f) of the Trademark Act

Given that Applicant's Mark is not generic, Applicant's Mark should proceed to publication.¹ At a minimum, Applicant's Mark should proceed as having acquired

¹ The Examining Attorney claims that Applicant's claim of acquired distinctiveness "in effect" concedes that Applicant's Mark is merely descriptive. Applicant makes no such concession. In support of the proposition, the Examining Attorney cites *In re Leatherman Tool Group, Inc.*, 32 USPQ2d 1443, 1444 (T.T.A.B. 1994). The plain language of *Leatherman* makes clear that *Leatherman* is inapplicable to this case. The paragraph cited by the Examining Attorney explains that the basis of the initial application in that case was Section 2(f) of the Trademark Act, and for that reason it was treated as a concession on the point of inherent distinctiveness. Furthermore, TMEP § 1212.02(c) is unequivocal that, "Unlike the situation in which an applicant initially seeks registration under §2(f) or amends its application without objection, [claiming acquired distinctiveness in the alternative to the initial filing basis] does not constitute a concession that the matter sought to be registered is not inherently distinctive." TMEP § 1212.02(c). See also: *In re E S Robbins Corp.*, 30 USPQ2d 1540, 1542 (TTAB 1992); *In re Professional Learning Centers, Inc.*, 230 USPQ 70, 71 n.2 (TTAB 1986); TMEP § 1212.02(b), ("[C]laiming distinctiveness in the alternative is *not* an admission that the proposed mark is not inherently distinctive." (emphasis in the original)). As

distinctiveness under Section 2(f) of the Trademark Act. In *Board of Supervisors v. Smack Apparel Co.*, 550 F.3d 465, 476 (5th Cir. 2008), the Fifth Circuit outlined several factors to consider regarding secondary meaning: (1) length and manner of use of the mark or trade dress, (2) volume of sales, (3) amount and manner of advertising, (4) nature of use of the mark or trade dress in newspapers and magazines, (5) consumer-survey evidence, (6) direct consumer testimony, and (7) a defendant's intent in copying the trade dress. *Id.* at 476. An applicant must make a *prima facie* showing of acquired distinctiveness. *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 6 U.S.P.Q.2d 1001 (Fed. Cir. 1988).

In the Response to Office Action, Filed September 13, 2010, Applicant submitted and discussed substantial evidence of acquired distinctiveness. This evidence addressed the factors laid out by *Smack Apparel*. Applicant then cited the treatment of these factors' treatment *In re Mine Safety Appliances Co.*, 66 U.S.P.Q.2d 1694 (T.T.A.B. 2002), and noted that evidentiary submissions in this case exceeded those held to be sufficient in *Mine Safety Appliances*.

The Examining Attorney dismissed the foregoing evidence as insufficient to show acquired distinctiveness. First, the Examining Attorney said that the admittedly-high sales figures and significant advertising expenditures may indicate commercial success instead of secondary meaning. Second, the Examining Attorney noted that advertising expenditures are indicative of efforts to develop source-identification, not necessarily success.

Stating "more evidence may be necessary," the Examining Attorney did not address the import of Applicant's five years of exclusive use and protection of Applicant's Mark. The

(continued...)

noted on the Application to Register, Applicant's initial basis for registration is Section 1(a) of the Trademark Act. The Section 2(f) claim is made in the alternative to the 1(a) finding. As such, Applicant does not concede that Applicant's Mark is merely descriptive.

Examining Attorney did not address Applicant's evidence depicting Applicant's Mark's treatment in trade publications and magazines. The Examining Attorney did not address Applicant's evidence of consumer and retailer surveys. The Examining Attorney did not address the implications of competitors' imitation of Applicant's Mark. In fact, Applicant has submitted evidence concerning each of the *Smack Apparel* factors, several of which the Examining Attorney ignored. Applicant contends these satisfy the Applicant's *prima facie* burden.

a. Applicant's Competitors Have Intentionally Copied Applicant's Mark

Preeminent among Applicant's previously-submitted evidence is the fact that Applicant's competitors have intentionally copied Applicant's Mark is alternatively sufficient. Intentional copying is strong evidence of secondary meaning because there is no reason for precise copying other than an attempt to capitalize upon existing secondary meaning of a mark. *Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters, Inc.*, 280 F.3d 619, 639 (6th Cir. 2002); *Transgo, Inc. v. Ajac Transmission Corp.*, 768 F.2d 1001, 1016 (9th Cir. 1985) ("proof of exact copying, without any opposing proof, can be sufficient to establish secondary meaning").

b. For The Five Years Preceding The Application, Consumers Exclusively Associated Applicant's Mark With Goods Originating From Applicant.

The mere fact that competitors intentionally copy Applicant's Mark is enough to establish the *prima facie* evidence of acquired distinctiveness of Applicant's Mark. Similarly, evidence of five years' exclusive, continuous use of Applicant's Mark is, by itself, enough to make a *prima facie* showing of acquired distinctiveness. See: Section 2(f) of the Trademark Act ("The Director may accept as *prima facie* evidence that the mark has become distinctive . . . proof of substantially exclusive and continuous use . . . of a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made."); TMEP § 1212.05(b). Applicant has submitted evidence that, for over five years, Applicant was the only seller in the

United States of a fish-oil supplement at a dosage and flavor appropriate for children. *See*: Response to Office Action Filed September 13, 2010, Exhibit 1: Declaration of Joar Opheim, CEO of Nordic Naturals. Thus, in that time period, every time any consumer or trade publication referred to “CHILDREN’S DHA,” that consumer or publication was necessarily referring to Applicant’s product. As the Applicant has made a *prima facie* showing for acquired distinctiveness, the Examining Attorney must either present evidence to the contrary, or approve Applicant’s Mark for registration.

3. The Stylized Nature Of Applicant’s Mark Warrants A Disclaimer And Registration

Even if the Examining Attorney finds the words of Applicant’s Mark generic or merely descriptive, Applicant’s Mark should be registered because it is highly stylized. Stylized marks can be registered when the “stylization of the words or the accompanying design features of the asserted mark create an impression on purchasers separate and apart from the impression made by the words themselves.” *In re American Academy of Facial Plastic and Reconstructive Surgery*, 64 U.S.P.Q.2d 1748, 1753 (T.T.A.B. 2002); *In re Venturi, Inc.*, 197 U.S.P.Q. 714 (T.T.A.B. 1977) (holding that a stylized version of the mark “THE PIPE” had acquired distinctiveness). Distinctive lettering, coloring or other design elements are capable of rendering a mark registrable even when combined with generic words. *Courtenay Communications Corp. v. Hall*, 334 F.3d 210, 216 (2d Cir. 2003); *In re the Wella Corporation*, 193 USPQ 585, 586 (T.T.A.B. 1977) (noting that a disclaimer of literal terms renders the descriptiveness of those terms moot).

The holding in *In re Jackson Hole Ski Corp.*, 190 USPQ 175, (T.T.A.B. 1976) is an example of these principles. In *Jackson Hole*, the literal mark consisted of the geographical name, “Jackson Hole,” and the applicant tried to register the stylized design of the letters “J” and

“H.” The applicant asserted that the letters were arranged distinctively and prominently displayed, creating a separate commercial impression from the literal and unregistrable words “Jackson Hole.” *Id.* at 176. The Board agreed and approved registration. *Id.* See also: *In re Miller Brewing Company*, 226 U.S.P.Q. at 667-668 (holding that the script rendition of “LITE” on beer labels was registrable).

In the Response to Office Action, Applicant noted that Applicant’s Mark consists of highly a stylized version of the phrase “CHILDREN’S DHA.” The letters of Applicant’s Mark are shown in a distinctive and unique “handwritten” format and font. Each letter is presented in distinctive, unique colors which are claimed elements of Applicant’s Mark as set forth in the application. Applicant contends that the overall combination makes a distinctive impression on purchasers separate and apart from the impression made by the words themselves. On this basis alone, the mark should proceed to registration.

CONCLUSION

The Examining Attorney misapplied the law in evaluating the Applicant’s Mark. The evidence submitted by the Examining Attorney falls short of the “clear evidence” standard necessary for finding genericness. Furthermore, the Applicant has presented sufficient evidence to show acquired distinctiveness for the “CHILDREN’S DHA” mark. In light of the foregoing, Applicant’s Mark should proceed to publication.